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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/556,964	11/09/2006	Gene Huh	5703-000012/US/NP	4110

27572 7590 07/09/2009

HARNESS, DICKEY & PIERCE, P.L.C.
P.O. BOX 828
BLOOMFIELD HILLS, MI 48303

EXAMINER	
STEITZ, RACHEL KUNNING	

ART UNIT	PAPER NUMBER
3732	

MAIL DATE	DELIVERY MODE
07/09/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/556,964	HUH, GENE	
	Examiner	Art Unit	
	RACHEL R. STEITZ	3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 April 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-13,18 and 20-26* is/are pending in the application.

4a) Of the above claim(s) *9* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-8,10-13,16,18 and 20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1, 3-5, 8, 10, 13, 18, 20, 21, 22, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese reference 2-249504 herein referred to as Reference '504 in view of Tan (US 6,390,434).

Regarding claim 1, Reference '504 discloses, a self-erecting structure for a rod-shaped member comprising a rod-shaped member (5) including a rod part having one end and another end and an erecting operation part (4) provided at the one end of the rod part (see Figure 1; abstract). A container (1) includes a mount surface (6) capable of accommodating the rod member in a lying position; the mount surface has an erecting action surface (3) for the erecting operation part of the rod member to perform an erecting action thereon (see Figures 1 and 2). The container further includes a lid (2) capable of opening and closing an open part of the mount surface (see Figures 1 and 2). The erecting operation part of the rod member has a rolling surface (i.e. bottom part of 4) that is rollable on the erecting action surface in an erecting direction of the rod member (see Figures 5 and 6). An erecting support surface (i.e. end of 5) is formed adjacent to and forward of the rolling surface at one end of the rod member and a first magnet (4) is provided in a vicinity of the erection support surface the first magnet has a

first magnetic pole facing toward the one end of the rod member so that the magnetic force from the first magnetic pole acts on the erection support surface (see Figures 1-3, abstract). The container (1) has a second magnet (3) provided in a vicinity of the erecting action surface the second magnet has a second magnetic pole opposite in polarity to the first magnetic pole and the second magnetic pole faces upward so that magnetic force from the second magnetic pole acts on the erecting action surface wherein the rod member is constantly urged to pivot in the erection direction by magnetic attraction force between the first magnetic pole and the second magnetic pole (see Figures 1 and 5; abstract). The lid (2) of the container (1) has an erection restraining part (i.e. the position located next to mirror 7) capable of holding the rod member in the lying position on the mount surface against urging form acting on the rod member in the erecting direction when the lid is closed (see Figure 2). Reference '504 does not disclose the second magnet provided directly under the mount surface.

Tan teaches a second magnet located directly under the mount surface (see Figure 6). It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the second magnet of Reference '504 located in the vicinity of the erecting action surface with a second magnet located directly under the mount surface as taught by Tan, since the simple substitution of one know element (i.e. magnet) for another to obtain predictable results would have been obvious at the time the invention was made. KSR International co. V. Teleflex Inc., 550 U.S. --, 82 USPQ2d 1385 (2007).

Regarding claims 3 and 8, Reference '504 discloses the claimed invention except for the erecting operation part of the rod member is formed from a spherical or ellipsoidal magnet and the rolling surface is a curved surface around the magnetic pole points operating as the first magnetic pole.

Regarding claim 4, Reference '504 discloses the lid opening and closing by pivoting around a pivot shaft (1a) and the erecting action surface being positioned on the mount surface closer to the pivot shaft of the lid and a pivoting direction of the rod member when shifting from the erect position to the lying position is the same as a pivoting direction of the lid from an open position to the closed position (see Figures 1 and 2).

Regarding claim 10, Reference '504 discloses the lid opening and closing by pivoting around a pivot shaft (1a) and the erecting action surface of the rod member is flat wherein when the rod member is in the erect position with the erection support surface facing the erecting action surface the rod member stands at a tilt to the pivot shaft of the lid that that the rod member is shiftable from the erect position to the lying position on the mount surface by pivoting down toward the pivot shaft in linkage with a closing motion of the lid (see Figures 1 and 2).

Regarding claim 13, Reference '504 discloses the container being a case body of a cosmetic compact case and the rod member being a makeup brush (see Figure 1).

Tan teaches a spherical magnet (12) with a curved rolling surface (see Figure 5; column 2, lines 45-50). It would have been obvious to one having ordinary skill in the

art at the time the invention was made to modify the magnet of Reference '504 with a spherical magnet as taught by Tan in order to allow the rod member to move in any direction (i.e. left or right).

Regarding claim 5, Reference '504 discloses the claimed invention except for the erection operation part is provided at one end of a cap wherein the cap has an opening that fits to a shape of the one end of the rod.

Tan teaches erection operation part provided at one end with a cap (24) wherein the cap has an opening (see Figure 6; column 3, lines 30-35). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the magnet of Reference '504 with a cap provided at one end of the erection operation part as taught by Tan in order to protect the magnet to extend their life.

Regarding claim 18, Reference '504 discloses the container being a case body of a cosmetic compact case and the rod member being a makeup brush (see Figure 1).

Regarding claim 20, Reference '504 discloses, a self-erecting structure for a rod-shaped member comprising a rod-shaped member (5) including a rod part having one end and an other end and an erecting operation part (4) provided at the one end of the rod part (see Figure 1; abstract). A container (1) includes a mount surface (6) capable of accommodating the rod member in a lying position; the mount surface has an erecting action surface (3) for the erecting operation part of the rod member to perform an erecting action thereon (see Figures 1 and 2). The container further includes a lid (2) capable of opening and closing an open part of the mount surface (see Figures 1 and 2). The erecting operation part of the rod member has a rolling surface (i.e. bottom

part of 4) that is rollable on the erecting action surface in an erecting direction of the rod member (see Figures 5 and 6). An erecting support surface (i.e. end of 5) is formed adjacent to and forward of the rolling surface at one end of the rod member and a first magnet (4) is provided in a vicinity of the erection support surface the first magnet has a first magnetic pole facing toward the one end of the rod member so that the magnetic force from the first magnetic pole acts on the erection support surface (see Figures 1-3, abstract). The container (1) has a second magnet (3) provided in a vicinity of the erecting action surface the second magnet has a second magnetic pole opposite in polarity to the first magnetic pole and the second magnetic pole faces upward so that magnetic force from the second magnetic pole acts on the erecting action surface wherein the rod member is constantly urged to pivot in the erection direction by magnetic attraction force between the first magnetic pole and the second magnetic pole (see Figures 1 and 5; abstract). The lid (2) of the container (1) has an erection restraining part (i.e. the position located next to mirror 7) capable of holding the rod member in the lying position on the mount surface against urging form acting on the rod member in the erecting direction when the lid is closed (see Figure 2). Reference '504 does not disclose the container having a ferromagnetic material provided directly under the mount surface.

Tan teaches a second magnet (i.e. ferromagnetic material) located directly under the mount surface (see Figure 6). It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the second magnet of Reference '504 located in the vicinity of the erecting action surface with a second

magnet located directly under the mount surface as taught by Tan, since the simple substitution of one know element (i.e. magnet) for another to obtain predictable results would have been obvious at the time the invention was made. KSR International co. V. Teleflex Inc., 550 U.S. --, 82 USPQ2d 1385 (2007).

Regarding claim 21, Reference '504 discloses the claimed invention except for the rolling surface having a spherical or ellipsoidal shape.

Tan teaches a spherical magnet (12) with a curved rolling surface (see Figure 5; column 2, lines 45-50). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the magnet of Reference '504 with a spherical magnet as taught by Tan in order to allow the rod member to move in any direction (i.e. left or right).

Regarding claim 22, Reference '504 discloses the rod-shaped member extending gat a non-perpendicular angle with respect to the mount surface when the rod-shaped member is held in the erect position (see Figure 1).

Regarding claim 26, Reference '504 discloses the mount surface having the erecting action surface being part of the lid and the erection restraining part being part of a base of the container (see Figure 1).

3. Claims 6, 7, 12, and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese reference 2-249504 in view of Tan as applied to claims 1, 3-5, 8, 10, 13, 18, 20, 21, and 26 above, and further in view of Joulia (US 6,286,521).

Regarding claim 6, Reference '504 discloses the claimed invention except for a second rod-shaped member side-by-side with the first rod member wherein the second rod member is formed with a second erecting action surface and the rod members are spaced from each other to an extend that when erecting operation parts of the rod members are positioned on the first and second erecting action surface the magnet of the first rod member does not attract a magnet of the second rod member.

Joulia teaches a first (31) and second rod-shaped member (32) side-by-side wherein the rod members are spaced from each other (see Figure 1). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the device of Reference '504 be made with a second rod-shaped member located next to the first rod member and having a second erecting action surface and a second magnet, since Joulia teaches that having two applicator members located side-by-side are will known in the art to provide the user with two applicator members. Further it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. St. Regis Paper Co. v. Bemis Co., 193 USPQ 8.

Regarding claim 7, the combination of Reference '507 and Joulia disclose the claimed invention except for the first rod member and the second rod member pivoting toward each other when shifting from an erect position to a lying position. It would have been obvious to one having ordinary skill in the art at the time the invention was made to arrange the first and second rod members wherein the first and second members pivot toward each other when sifting from an erect position to a lying position, since it

has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 UPSQ 70.

Regarding claim 12, the combination of Reference '504 and Joulia disclose the lid (2) opening and closing about a pivot shaft (1a) and a pivoting guide surface (i.e. the lid part next to mirror (7)) is formed on an inner side of the lid whereby when the lid is closed the pivoting guide surface abuts on distal ends of the rod members and guides the rod members so that the rod members pivot toward each other.

Regarding claims 23-25, Reference '504 discloses the claimed invention except for the rod-shaped member moves in a first pivoting direction when shifting from the erect position to the lying position and wherein the lid moves in a second pivoting direction when shifting from an open position to a closed position and the first pivoting direction and the second pivoting direction being different from each other. Joulia teaches that having the rod-shaped member being located perpendicular to the base, therefore, it would have been obvious to one having ordinary skill in the art to have the rod shaped member be located perpendicular to the base (see Figure 1), since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 UPSQ 70.

4. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese reference 2-249504 view of Tan as applied to claims 1, 3-5, 8, 10, 13, 18, 20, 21, and 26 above, and further in view of Kunik et al. (US 3,982,631).

Regarding claim 11, Reference '504 discloses the claimed invention except for the erecting action surface is linearly slanted so that when the rod member is in the erect position with the erection support surface facing the erection action surface the rod member stands at a tilt.

Kunik et al. teaches the erecting action surface (41) being linearly slanted so that when the rod member is in the erect position with the erection support surface facing the erection action surface the rod member stands at a tilt (see Figures 2 and 8; column 3, lines 20-30). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the erecting action surface of Reference '504 to be linearly slated as taught by Kunik et al. in order to allow rod member to be provided at an angle.

Response to Arguments

5. Applicant's arguments filed April 16, 2009 have been considered but are moot in view of the new ground(s) of rejection.

6. In response to applicant's argument that Tan is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Tan is pertinent to the particular problem with which the applicant was concerned, i.e. having the magnet be spherical or ellipsoidal in order to allow the member to roll).

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RACHEL R. STEITZ whose telephone number is (571)272-1917. The examiner can normally be reached on Monday-Friday 7:00 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez can be reached on (571) 272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robyn Doan/
Primary Examiner, Art Unit 3732

/Rachel Running Steitz/
Examiner
Art Unit 3732

6/30/2009